

REMARKS

Claims 1 and 11 have been amended. Claims 2 and 3 have been canceled. New Claim 12 has been added. Thus, Claims 1 and 4-12 are now pending in the present application. Support for the amendment to claim 1 may be found in original claims 2 and 3. Support for new claim 12 may be found in original claims 1 and 4. Accordingly, the amendments do not add new matter and entry thereof is respectfully requested. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

Rejection under 35 U.S.C. 102(b)

Claims 1, 4-5, 8 and 10-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Malik et al. (SPIE Vol. 3678). Claim 1 as amended recites the subject matter from canceled claims 2 and 3 which is not disclosed by this reference, and these claims were not rejected as being anticipated by this reference. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. 102(a)

Claims 1, 4-8 and 10-11 were rejected under 35 U.S.C. 102(a) as being anticipated by Momoto Atsushi et al. (JP2003-307840). The publication date of this reference is October 31, 2003, which is after the priority date of the present application (April 30, 2003). Enclosed herewith is a certified English translation of the priority document (Japanese Patent Application No. 2003-125242). The certified translation is virtually identical to the present application and fully supports the pending claims. Thus, Momoto Atsushi et al. does not qualify as prior art against the present application. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. 102(a or e)

Claims 1, 4-7, 8 and 10-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al. (US2003/0232273). Claim 1 as amended recites the subject matter from canceled claims 2 and 3 which is not disclosed by this reference, and these claims were not rejected as being anticipated by this reference. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections under 35 U.S.C. 103(a)

Malik et al. (6,133,412) in view of Malik et al. (SPIE Vol. 3678)

Claims 1-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al. (6,133,412) in view of Malik et al. (SPIE Vol. 3678). The Examiner contends that the use of naphthyl groups for reducing volatility and contamination of the optics as well as improving etch resistance as taught by Malik et al. (SPIE) to form part of the Mixture of Malik et al. (6,133,412) would have been *prima facie* obvious. However, neither Malik et al (6,133,412) nor Malik et al. (SPIE Vol. 3678) teach or suggest that component (A) can be a mixture of a polymer and a copolymer comprising the particular structural units as recited in amended claim 1. Nothing in either of these references would even suggest these particular structural units. Thus, these references provide no motivation or suggestion to one of ordinary skill in the art to make the combination to arrive at the claimed invention. As such, a *prima facie* case of obviousness cannot be maintained.

In addition, the positive resist composition as recited in amended claim 1 has superior properties that could not have been predicted based upon the cited references. For example, the specification at page 9, lines 14-16 states that "by using this type of mixture as the component (A), the shape of the formed resist pattern exhibits favorable rectangularity, and a superior isolated line pattern can be obtained." These unexpected properties would rebut a *prima facie* showing of obviousness even if such a showing were present.

Iwanaga Shinichiro et al. (JP 11-002902)

Claims 1, 4-6, 8 and 10-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Iwanaga Shinichiro et al. (JP 11-002902) as evidenced by the Machine English translation thereof and AN 1999:23513 and Derwent-Acc-No: 1999-126674. Claim 1 as amended recites the subject matter from canceled claims 2 and 3 which is neither disclosed or suggested by this reference, and these claims were not rejected as being obvious in view of this reference. Thus, withdrawal of the rejection is respectfully requested.

Tanabe Takayoshi et al. (JP 11-030865)

Claims 1, 4-8 and 10-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tanabe Takayoshi et al. (JP 11-030865) as evidenced by the Machine English translation thereof. Claim 1 as amended recites the subject matter from canceled claims 2 and 3 which is not disclosed or suggested by this reference, and these claims were not rejected as being obvious in view of this reference. Thus, withdrawal of the rejection is respectfully requested.

In view of the claim amendments and comments presented above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

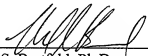
CONCLUSION

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited. If any minor issues remain which could be resolved by telephone, the Examiner is invited to contact the undersigned at the number provided below.

Respectfully submitted,

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